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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,496	10/22/2001	Timothy I. Moodycliff	J 3317	2275

28165 7590 01/09/2006

S.C. JOHNSON & SON, INC.
1525 HOWE STREET
RACINE, WI 53403-2236

EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,496

Applicant(s)

MOODYCLIFFE, TIMOTHY I.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/13/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The following is in response to the applicant's amendments and arguments filed 10/13/05.
2. Concerning Morrison '068, the applicant argues that the thickener is separate from the petroleum distillate as it is prepared separately and only later added to the petroleum distillate.
3. The examiner appreciates the applicant's argument, however the instant claims are directed to a final composition and not to a process for forming the final composition. As such the examiner does not consider sub-compositions as separate compositions from the final composition. There is only a final composition in a composition claim. As all material limitations have been met, such arguments are not considered convincing.
4. The applicant further asserts that the hydrocarbon oil does not encompass the petroleum distillate. The examiner disagrees with this argument. The term "hydrocarbon oil" encompasses millions of compounds including the petroleum distillate.
5. Concerning Graveske '810, the applicant argues that resins are different from oil. It is not clear how this argument relates to the previous rejection. The examiner clearly states that solvents are used which include xylene, toluene, mineral spirits, etc. These solvents are clearly not resins and also clearly read on the broad term "hydrocarbon oil." Thus these rejections are maintained.

6. Concerning the double patenting rejection, the applicant argues that the instant claims do not require the "solid." The examiner does not accept this argument because the applicant's claims contain the transitional phrase "comprising" which would allow the inclusion of addition ingredients including the "hydrocarbon-insoluble solid." Omitting an element from a previous claim does not overcome an ODP rejection, especially when the instant claims remain open to additional elements. Thus these claims remain.
7. Concerning the newly added claims, as these claims are directed to a "product by process" very little weight is granted to the process. As such, these claims are more broadly disclosed than instant claim 13. Again in composition claims, the final composition is being claimed, not individual sub-compositions, not process limitations, not intended use limitations. As the examiner has found all material limitations such new claims would also be rejection by the previously applied prior art.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 13, 15-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Morrison et al (US 6,433,068) for those reasons set forth in the previous action as well as those arguments presented above.

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3. Claims 13, 15-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Graveske (6,350,810), for those reasons set forth in the previous action as well as those arguments presented above.

Double Patenting

4. Claims 13, and 15-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,433,068. Although the conflicting claims are not identical, they are not patentably distinct from each other because the prior art teaches each and every material limitation described in the instant claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'G. Webb', with a large, stylized initial 'G'.

Gregory E. Webb
Primary Examiner
Art Unit 1751

gew